

REMARKS

The Office Action dated January 26, 2009 has been received and carefully considered. Claims 1-33 are pending in the application. Claims 1, 5, 6, 12, 16, 17, 23, 25-28, and 30-33 have been amended. Claims 4 and 15 have been cancelled without prejudice or disclaimer. No new matter has been added by the above amendments to the claims. Applicants believe that the application is in condition for allowance and notice thereof is respectfully requested.

1. Claims 1, 12, 23, and 28 are directed to statutory subject matter

Claims 1, 12, 23, and 28 (including their dependent claims) are rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicants respectfully disagree. However, to advance the claims toward allowance, Applicants respectfully submit amendments to claims 1, 12, 23, and 28 in order to further clarify that the claims are directed to statutory subject matter.

The Court of Appeals for the Federal Circuit held in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), that the “definitive test” for whether a claimed process complies with 35 U.S.C. § 101 is the “machine-or-transformation” test where a “claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954.

Applicants respectfully submit that the amendments to claims 1, 12, 23, and 28 clarify that the claims are “tied to a particular machine or apparatus” under the *Bilski* test. All dependent claims associated with independent claims 1, 12, 23, and 28 are themselves allowable at least as being dependent upon an independent claim. Applicants respectfully request that the rejection of claims 1, 12, 23, and 28, and all associated dependent claims, under 35 U.S.C. § 101 be withdrawn.

2. The Rejection of Claims 1-33 Under 35 U.S.C. § 112 Should be Withdrawn

Claims 12 and 28 (including their dependent claims) are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being confusing. Applicants respectfully

disagree that the claims are “confusing.” However, as shown above, Applicants respectfully submit amendments to claims 12 and 28 to clarify that the claims are “tied to a particular machine or apparatus.” Applicants respectfully request that the rejection of claims 12 and 28 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 1-11, 12-22, 23-27, 28-32, and 33 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for reciting “RFID.” Applicants respectfully disagree that this term is ambiguous, but respectfully submit amendments to the independent claims to clarify “RFID.” Applicants respectfully request that the rejection of claims 1-11, 12-22, 23-27, 28-32, and 33 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 5, 6, 16, 17, 23, 25, 26, 28, 30, and 31, as well as all dependent claims depending therefrom, are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for reciting the term “may.” Applicants respectfully disagree that the term renders the claims indefinite, but respectfully submits amendments to claims 5, 6, 16, 17, 23, 25, 26, 28, 30, and 31 in an effort to advance prosecution. Applicants respectfully request that the rejection of claims 5, 6, 16, 17, 23, 25, 26, 28, 30, and 31, as well as all dependent claims depending therefrom, under 35 U.S.C. § 112, second paragraph, be withdrawn.

3. The Rejection of Claims 1, 3, 6-11, 12, 14-22, 23, 25-27, 28, 30-32, and 33 Under 35 U.S.C. § 102(b) is Improper

Claims 1, 3, 6-11, 12, 14-22, 23, 25-27, 28, 30-32, and 33 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 97/24689 (“Giordano”).

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Celeritas Tech., Ltd., v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). The prior art reference must disclose all of the claim elements arranged or combined in the same

way as recited in the claim. *Net Money/IN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). “In addition, the prior art reference must be enabling.” *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. *Id.*

Giordano is directed to a fuel dispenser with RFID capabilities. Giordano, Abstract. A customer receives an RFID transponder and approaches a station equipped with RFID readers. Giordano Summary, page 5. The transponder signals an ID to the reader, and the customer identification data is associated with a transaction. Giordano Summary, page 5. The computer system associated with the reader “is used to determine whether the customer account number is valid for purchases.” Giordano, page 35. “The authorization might consist only of recognizing that the customer identification is a valid identification or of the correct number of characters. However, in most applications of the system 10, some form of database credit authorization will be desired. Giordano, page 35. In some instances, the “network keeps track of the customer’s past purchases and buying preferences and provides rewards for frequent purchases. . . [t]he network can also keep a profile of the customer and provide customized service for the customer based on the profile.” Giordano, page 55. Giordano discloses only that a “network” *of the merchant* may “keep track of the customer’s past purchases,” not that the network is associated with the financial provider. Also, Giordano does not disclose that the RFID “transponder” that the customer uses to access the system is a financial card, as recited in claim 1. In fact, Giordano discloses only that the transponders are “mounted to the customers’ cars or may be hand-held, key ring/chain or credit card *style* units.” Giordano, page 9 (emphasis added). Nowhere does Giordano disclose that the transponders are financial cards, or that they can be used for any purpose other than to access the particular merchant’s system.

In view of the language of claim 1, Giordano does not disclose “causing the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account,” as Giordano does not disclose storage associated with the financial card provider. Therefore, Giordano necessarily cannot disclose “electronically identifying the financial account based on the identification data[, and] retrieving from electronic storage the stored purchase history information associated with the identified financial account. . .” as recited in claim 1. Giordano does not disclose that storage is associated with a financial card provider, and so does not disclose the identification and retrieval of information from storage associated with a financial card provider.

Claims 3 and 6-11 are allowable at least as being dependent from allowable claim 1. Thus, Applicants respectfully submit that claims 3 and 6-11 are allowable over Giordano.

Claim 12 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 12 recites, in pertinent part, “a data storage module operable to cause the received purchase information to be stored in electronic storage associated with the financial card provider. . .” and “retrieving from electronic storage the stored purchase history information associated with the identified financial account.” As discussed above with respect to claim 1, Giordano fails to teach or suggest “a data storage module operable to cause the received purchase information to be stored in electronic storage associated with the financial card provider. . .” and “retrieving from electronic storage the stored purchase history information associated with the identified financial account.”

Claims 14-22 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 14-22 are allowable over Giordano.

Claim 23 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 23 recites, in pertinent part, “storing the received purchase information in electronic storage associated with the financial card issuer separate from the card” As discussed above with respect to claim 1, Giordano fails to teach or

suggest “storing the received purchase information in electronic storage associated with the financial card issuer separate from the card”

Claims 25-27 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 25-27 are allowable over Giordano.

Claim 28 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 28 recites, in pertinent part, “store the received purchase information in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .” As discussed above with respect to claim 1, Giordano fails to teach or suggest “store the received purchase information in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .”

Claims 30-32 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 30-32 are allowable over Giordano.

Claim 33 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 33 recites, in pertinent part, “electronically receive purchase information from one or more purchases made from a particular merchant using a financial card affiliated with the particular merchant and provided to the customer by a financial card provider. . . .” and “cause the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .” As discussed above with respect to claim 1, Giordano fails to teach or suggest “electronically receive purchase information from one or more purchases made from a particular merchant using a financial card affiliated with the particular merchant and provided to the customer by a financial card provider. . . .” and “cause the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .”

4. The Rejection of Claims 1-5, 10-11, 12-16, 21-22, 23-25, 28-30, and 33 Under 35 U.S.C. § 102(b) is Improper and Should be Withdrawn

Claims 1-5, 10-11, 12-16, 21-22, 23-25, 28-30, and 33 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Publication No. 2002/0174025 ("Hind").

Hind discloses a method for providing targeted advertising and customer services. Hind, Abstract. The system includes a shopping card attachment device that customers use during shopping. Hind, [0031]. A customer card reader is associated with the shopping card attachment device and reads a customer card. Hind, [0032]. The customer card includes a storage unit "for storing the customer's personal information, preference information, etc." Hind, [0032]. In alternate embodiments, "the customer's preference information is prestored at a central location and is retrieved selectively based on a unique customer ID associated with the stored preference information." Hind, [0035]. "Preference information" is defined in paragraph [0024]. Hind does not disclose that the database containing customer information is associated with a financial card provider, nor does Hind disclose that data is retrieved from storage other than storage associated with a particular merchant. Put another way, Hind discloses only that "preference information" is associated with a single merchant.

Similarly to Giordano, above, Hind does not disclose "causing the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account," as Hind does not disclose storage associated with the financial card provider. Therefore, Hind necessarily cannot disclose "electronically identifying the financial account based on the identification data[, and] retrieving from electronic storage the stored purchase history information associated with the identified financial account. . ." as recited in claim 1. Hind does not disclose that storage is associated with a financial card provider, and so does not disclose the identification and retrieval of information from storage associated with a financial card provider.

Claims 2-5 and 10-11 are allowable at least as being dependent from allowable claim 1. Thus, Applicants respectfully submit that claims 2-5 and 10-11 are allowable over Hind.

Claim 12 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 12 recites, in pertinent part, “a data storage module operable to cause the received purchase information to be stored in electronic storage associated with the financial card provider. . .” and “retrieving from electronic storage the stored purchase history information associated with the identified financial account.” As discussed above with respect to claim 1, Hind fails to teach or suggest “a data storage module operable to cause the received purchase information to be stored in electronic storage associated with the financial card provider. . .” and “retrieving from electronic storage the stored purchase history information associated with the identified financial account.”

Claims 13-16 and 21-22 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 13-16 and 21-22 are allowable over Hind.

Claim 23 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 23 recites, in pertinent part, “storing the received purchase information in electronic storage associated with the financial card issuer separate from the card” As discussed above with respect to claim 1, Hind fails to teach or suggest “storing the received purchase information in electronic storage associated with the financial card issuer separate from the card”

Claims 24-25 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 24-25 are allowable over Hind.

Claim 28 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 28 recites, in pertinent part, “store the received purchase information in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .” As discussed above with respect to claim 1, Hind fails to teach or suggest “store the received purchase information in electronic storage associated with the financial card

provider separate from the card as purchase history information associated with the financial account. . . .”

Claims 29-30 are allowable at least as being dependent from allowable claim 12. Thus, Applicants respectfully submit that claims 29-30 are allowable over Hind.

Claim 33 is allowable for similar reasons as discussed above regarding claim 1. Specifically, claim 33 recites, in pertinent part, “electronically receive purchase information from one or more purchases made from a particular merchant using a financial card affiliated with the particular merchant and provided to the customer by a financial card provider. . . .” and “cause the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .” As discussed above with respect to claim 1, Hind fails to teach or suggest “electronically receive purchase information from one or more purchases made from a particular merchant using a financial card affiliated with the particular merchant and provided to the customer by a financial card provider. . . .” and “cause the received purchase information to be stored in electronic storage associated with the financial card provider separate from the card as purchase history information associated with the financial account. . . .”

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action, and the present application is in condition for allowance. If the Examiner believes, for any reason, that a personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

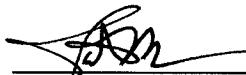
It is believed that only \$130.00 for a one month extension of time to reply is required for this response. If it is determined that additional fees are due, the Commissioner is hereby authorized to charge such fees to the undersigned's Deposit Account No. 50-0206 accordingly.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: May 26, 2009
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

By: 
Daniel G. Vivarelli, Jr.
Registration No. 51,137
Jonathan Burns
Registration No. 51,515

JBB:DGv/tmf